

REMARKS

I. Status of the Application

Claims 1-22 are pending in this application. In the December 23, 2008 Office action, the Examiner:

A. Rejected claims 13-20 under 35 U.S.C. § 101, as allegedly being directed to non-statutory subject matter;

B. Rejected claims 1, 10, 13, 20, and 22 under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the enablement requirement;

C. Rejected claims 1, 4, 6, 10, 13-20, and 22 under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite;

D. Rejected claims 1, 2-7, 13-15, and 20-22 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 7,065,457 to Germer et al. (hereinafter “Germer”) in view of U.S. Patent No. 4,918,728 to Matyas et al. (hereinafter “Matyas”), U.S. Patent No. 5,107,455 to Haines et al. (hereinafter “Haines”), and a report authored by Kinter-Meyer and Burus entitled, *Utility/Energy Management and Controls System (EMCS) Communication Protocol Requirements* (hereinafter “Kinter-Meyer”); and

E. Rejected claims 8-12 and 16-19 under 35 U.S.C. § 103(a) as being unpatentable over Germer in view of Matyas, in view of Haines, in further view of Kinter-Meyer, and in further view of U.S. Patent No. 5,715,390 to Hoffman et al. (hereinafter “Hoffman”).

In this response, Applicants have amended claims 1, 13, and 22. Applicants respectfully traverse the rejections of claims 1-22 in view of the foregoing amendments and the following remarks.

II. The Rejection of Claims 13-20 under 35 U.S.C. § 101 Should be Withdrawn

In the December 23, 2008 Office action, the Examiner rejected claims 13-20 under 35 U.S.C. § 101, because the claimed invention is allegedly directed to non-statutory subject matter. Applicants submit that claim 13 as amended complies with the statutory subject matter test as set forth in the recent Federal Circuit case of *In Re Bilski*, 545 F.3d 943 (Fed. Cir. 2008).

Under *In Re Bilski* “[a] claimed process is surely patent-eligible under § 101 if: (1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing”. As noted in *In Re Bilski*, the process for curing rubber claimed in *Diamond v. Diehr*, 450 U.S. 175 (1981) satisfies both prongs of the test, because the claimed process operates on a computerized rubber curing apparatus and transforms raw, uncured rubber into molded, cured rubber products. The process of *Gottschalk v. Benson*, 409 U.S. 63 (1972), however, does not satisfy the statutory subject matter test set forth in *In Re Bilski*, because the limitations tying the claimed process to a computer are not actually limiting because the fundamental principle at issue, a particular algorithm, has no utility other than operating on a digital computer.

Applicants submit that claim 13 satisfies at least prong (1) of the test set forth in *In Re Bilski*. In particular, claim 13 ties a “method for modifying a read-only table” to a “utility meter”. Utility meters are clearly a “particular machine or apparatus”. Additionally, in contrast to the *Gottschalk v. Benson* case cited in *In Re Bilski*, the method recited in claim 13 could be applied to other types of machines or apparatuses, which employ read-only tables; therefore, the limitations tying the method of claim 13 to a utility meter are indeed limiting. Accordingly, the non-statutory subject matter rejection of claim 13 should be withdrawn, because the method of claim 13 satisfies at least prong (1) of the test announced in *In Re Bilski*.

Claims 14-20 depend from and incorporate all of the limitations of amended claim 13. As set forth above, the 35 U.S.C. § 101 rejection of claim 13 should be withdrawn. Therefore, because each of dependent claims 14-20 depends from and incorporates all of the limitations of independent claim 13, the Examiner's rejection of dependent claims 14-20 under 35 U.S.C. § 101 should also be withdrawn for at least the same reasons.

III. The Rejection of Claims 1, 10, 13, 20, and 22 under 35 U.S.C. § 112, First Paragraph Should be Withdrawn

In the December 23, 2008 Office action, the Examiner rejected claims 1, 10, 13, 20, and 22 under 35 U.S.C. § 112, first paragraph, as allegedly “failing to comply with the enablement requirement”. (Page 3). Applicants respectfully traverse the Examiner's rejection of claims 1, 10, 13, 20, and 22 under 35 U.S.C. § 112, first paragraph.

On page 3 of the December 23, 2008 Office action, the Examiner alleged that “the claims and the specification do not describe how nor recite steps describing the ‘enabling’ that avoids or circumvents the security access tables designed to prevent unauthorized data access”.

Applicants respectfully submit that to comply with 35 U.S.C. § 112, first paragraph, “all that is necessary is that one skilled in the art be able to practice the claimed invention, given the level of knowledge of skill in the art.” (MPEP § 2164.08). Additionally, a patent need not teach, and preferably omits, what is well known in the art. (MPEP § 2164.01 citing *In re Buchner*, 929 F.2d 660, 661 (Fed. Cir. 1991)). Furthermore, “even if two distinct technologies are relevant to an invention, then the disclosure will be adequate if a person of ordinary skill in each of the two technologies could practice the invention from the disclosure”. (MPEP § 2164.05(b)).

In the present case, Applicants have not provided exhaustive details on the “enabling” required to bypass the security data tables because providing “enabling” signals within electronic devices is well known to those skilled in the art of electronic circuit design and in particular to those skilled in the art of electronic utility meters incorporating standard meter industry data tables, such as the ANSI C12.19 data structures. Furthermore, Applicants submit that the written description describes “the ‘enabling’ that avoids or circumvents the security access tables designed to prevent unauthorized data access” well enough for one skilled in the art to be able to practice to the claimed invention. One example of a description of the “enabling” is provided below:

Bypass component 54 includes an unlock timer 70 and a data access monitor 74. In response to the data operation enable signal, unlock timer 70 is initiated to time an unlock interval and data access monitor 74 monitors data access operations performed by the external device. Specification, page 10.

The written description clearly describes the “enabling” that avoids or circumvents the security access tables designed to prevent unauthorized data access. Therefore, it is respectfully submitted that the specification enables a person skilled in the art to which it pertains to use the invention commensurate in scope with claims 1, 10, 13, 20, and 22. As a result, the 35 U.S.C. § 112, second paragraph rejection of claims 1, 10, 13, 20, and 22 should be withdrawn.

IV. The Rejection of Claims 1, 4, 6, 10, 13-20, and 22 under 35 U.S.C. § 112, Second Paragraph Should be Withdrawn

In the December 23, 2008 Office action, the Examiner rejected claims 1, 4, 6, 10, 13-20, and 22 under 35 U.S.C. § 112, second paragraph, as allegedly “being indefinite for failing to

particularly point out and distinctly claim the subject matter which applicant regards as the invention”. (Page 3). As will be discussed below, the indefiniteness rejections should be withdrawn.

A. The § 112, Second Paragraph Rejection of Claims 1, 10, 13, 20, and 22 Should be Withdrawn

With respect to claims 1, 10, 13, 20, and 22, the Examiner alleged that “the claims and the specification do not describe how nor recite steps describing the ‘enabling’ that avoids or circumvents the security access tables designed to prevent unauthorized data access”. *Id.*

Applicants respectfully submit that, “the primary purpose of this requirement of definiteness of claim language is to ensure that the scope of the claims is clear so the public is informed of the boundaries of what constitutes infringement of the patent”. (MPEP § 2173). The Examiner’s statement makes no allegation that the scope of the claims is unclear. Accordingly, the rejection of claims 1, 10, 13, 20, and 22 is improper and should be withdrawn.

Furthermore, Applicants note the possibility that the claims 1, 10, 13, 20, and 22 were rejected in error. The Examiner’s reasoning for rejecting claims 1, 10, 13, 20, and 22 under § 112, second paragraph is virtually identical to the Examiner’s reasoning for the rejection of claims 1, 10, 13, 20, and 22 under § 112, first paragraph. If the rejection under § 112, second paragraph was made in error, Applicants respectfully submit that any revised rejection of claims 1, 10, 13, 20, and 22 under 35 U.S.C. § 112, second paragraph should not be made final in order to provide the Applicants with an opportunity to respond to the new grounds of rejection. (*See* MPEP § 706.07).

B. The § 112, Second Paragraph Rejection of Claims 4 and 14 Should be Withdrawn

With respect to claims 4 and 14, the Examiner alleged that “the terms ‘arithmetically combines’ and ‘arithmetically combining’ in claims 4 and 14 are relative terms which renders the claim indefinite”. (Referred to herein as the “terms in question”) (December 23, 2008 Office action, page 4). Additionally, the Examiner noted that “both terms are not defined by the claims, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention”. *Id.* Furthermore, in response to the Applicants’ arguments to the May 29, 2008 Office action, the Examiner noted that “the terms ‘arithmetically combines’ and ‘arithmetically combining’ is not supported by the specification, such as addition, subtraction, etc”. (*Id.* at page 2).

As presented below, the Examiner’s response to the Applicants’ arguments fails to consider the ordinary meaning of the terms in question. Furthermore, Applicants submit that the terms in question are neither relative terms nor terms of degree.

i. The Examiner’s Response to the Applicants Arguments Fails to Consider the Ordinary Meaning of the Terms in Question and Should be Withdrawn

The Examiner has alleged that the terms “arithmetically combines” and “arithmetically combining” are “not supported by the specification, such as addition, subtraction, etc”. As set forth in the MPEP, “the words of the claim must be given their plain meaning unless the plain meaning is inconsistent with the specification”. (MPEP § 2111.01 citing *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989)). Furthermore, “the ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, *i.e.*, as of the effective filing date of the patent application”. (MPEP § 2111.01 citing *Phillips v. AWH Corp.*, 415 F.3d 1303, 1313 (Fed. Cir. 2005) (*en banc*)).

Applicants submit that the ordinary meaning of the terms “arithmetically”, “combines”, and “combining” have been used in the claims. As presented in response to the May 29, 2008 Office action, Applicants noted that the ordinary meaning of the term “arithmetically” is “the mathematics of integers, rational numbers, real numbers, or complex numbers under addition, subtraction, multiplication, and division. THE AMERICAN HERITAGE® DICTIONARY OF THE ENGLISH LANGUAGE, Fourth Edition, 2000. Because the ordinary meaning of term “arithmetically” includes “addition, subtraction, multiplication, and division”, Applicants submit that the written description requires no further definition of the term. Therefore, the 35 U.S.C. § 112, second paragraph rejection of claims 4 and 14 should be withdrawn.

ii. “Arithmetically Combines” and “Arithmetically Combining” are not
Relative Terms nor Terms of Degree

In the December 23, 2008 Office action, the Examiner appears to have alleged that the terms “arithmetically combines” and “arithmetically combining” are relative terms or terms of degree. Applicants submit that “terms of degree” refer to words that encompass an uncertain range of possibilities, which makes the scope of what is claimed unclear. For example, the term “about” may be considered a relative term or a term of degree because as used in an exemplary context, such as “at least about”, the limits of what is claimed may not be accurately determined in some circumstances. (MPEP § 2173.05(b)).

In the present case, Applicants have used a term, namely “arithmetic”, that has clear and distinct boundaries. In particular, arithmetic is one of addition, subtraction, multiplication, and division. Furthermore, the terms “combines” and “combining” also have clear and distinct boundaries. Therefore, the terms “arithmetically combines” and “arithmetically combining” are

not terms of degree nor relative terms and the rejection of claims 4 and 14 under 35 U.S.C. § 112, second paragraph should be withdrawn.

Applicants further submit that even though the term “arithmetically” may refer to addition, subtraction, multiplication, and division the term is not indefinite as used in the claim. As mentioned above, § 112, second paragraph is a requirement to ensure the scope of a claim is well defined. Problems may arise with terms such as “about”, “essentially”, and “similar” because the terms do not denote an identifiable boundary, thereby making the scope of a claim uncertain in some situations. The term “arithmetically”, however, refers to four mathematical operations. Therefore, it is respectfully submitted that there is no issue regarding an uncertain claim scope. Therefore, the 35 U.S.C. § 112, second paragraph rejection of claims 4 and 14 should be withdrawn.

C. The § 112, Second Paragraph Rejection of Claims 6 and 15 Should be Withdrawn

With respect to claims 6 and 15 the Examiner alleged that “the terms ‘augments’ and ‘augmenting’ are relative terms which render the claim indefinite”. (December 23, 2008 Office action, page 4). Applicants submit that the terms “augments” and “augmenting” are not relative terms. Furthermore, even if the Examiner were to consider the terms to be relative terms, one of ordinary skill in the art would understand what is claimed.

As mentioned above, “the primary purpose of this requirement of definiteness of claim language is to ensure that the scope of the claims is clear so the public is informed of the boundaries of what constitutes infringement of the patent”. (MPEP § 2173). Usage of exemplary relative claims such as “about”, “essentially”, and “similar” may at times lead to indefinite claims because of the “range of degree” introduced by these terms. Applicants submit, however, that the terms “augments” and “augmenting” as used in claims 6 and 15 result in no such “range of

degree”. The claim language makes clear precisely what is being augmented; namely, the security key. Therefore, because the terms “augments” and “augmenting” clearly describe the scope of claims 6 and 15, the § 112, second paragraph rejection should be withdrawn.

Even if the terms “augments” and “augmenting” are considered to be relative terms this does not automatically render the claims indefinite. In particular, “the fact that claim language, including terms of degree, may not be precise, does not automatically render the claim indefinite under 35 U.S.C. § 112, second paragraph”. (MPEP § 2173.05(b), citing *Seattle Box Co. v. Industrial Crating & Packing, Inc.*, 731 F.2d 818 (Fed. Cir. 1984)). Additionally, “acceptability of the claim language depends on whether one of ordinary skill in the art would understand what is claimed, in light of the specification”. (MPEP § 2173.05(b)). With this guidance in mind, Applicants refer to page 11 of the specification which provides an exemplary meaning of the terms:

Preferably, both the external device and procedure augment the security key with additional data before submitting the security key to the function F_{ak} to generate the access key. This additional data is stored in the meter 10 by the manufacturer and is also stored in the external device.

The specification provides an example of how the security key is augmented, thereby enabling one of ordinary skill in the art to understand what is claimed. For at least the above reasons, the 35 U.S.C. § 112, second paragraph rejection of claims 6 and 15 should be withdrawn.

D. The § 112, Second Paragraph Rejection of Claims 13-20 Should be Withdrawn

The Examiner alleged that claims 13-20 “recite ‘receiving a request’, ‘generating a security key’, ‘comparing an access key...’, ‘enabling a data access operation’, without describing who or what is receiving, generating, comparing, etc., rendering the claims indefinite”. Applicants

have amended claim 13 to identify “who or what is receiving, generating, comparing etc”.

Accordingly the rejection of claim 13 under § 112, second paragraph should be withdrawn.

Claims 14-20 depend from and incorporate all the limitations of independent claim 13. Therefore, for at least the same reasons as set forth above in regard to claim 13, Applicant’s respectfully submit that the § 112, second paragraph rejections of claims 14-20 should also be withdrawn.

V. The Rejection of Claims 1, 13, and 22 Under 35 U.S.C. § 103(a) Should Be Withdrawn

In the December 23, 2008 Office action, the Examiner rejected claims 1, 13, and 22 under 35 U.S.C. § 103(a) as being unpatentable over Germer in view of Matyas, in view of Haines, and further in view of Kinter-Meyer (references referred to collectively as the “Cited References”). In this response, Applicants respectfully traverse the Examiner’s rejection of claims 1, 13, and 22 under 35 U.S.C. § 103(a), as the Examiner has failed to make a *prima facie* case of obviousness as described in MPEP § 2142-2143.

The Examiner’s rationale for a finding of obviousness in the December 23, 2008 Office action is not specifically stated in the context of the examples of MPEP § 2143. Applicants note, however, that pursuant to MPEP § 2143, “the key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious”. Furthermore, in order to establish a *prima facie* case of obviousness, three basic criteria should be met as set forth in MPEP § 2143.01-2143.03. First, the prior art reference (or references when combined) must teach or suggest all the claim limitations. (MPEP § 2143.03). Second, there must be a reasonable expectation of success. (MPEP § 2143.02). Third, there must be some suggestion or motivation to modify the references or combine reference teachings.

(MPEP § 2143.01). As discussed in detail below, the Examiner has failed to satisfy even one of the three basic criteria.

A. The Cited References do not Teach or Suggest all the Limitations of Claims 1, 13, and 22

It is respectfully submitted that the Examiner has failed to make a *prima facie* case of obviousness for at least the reason that none of Germer, Matyas, Haines and Kinter-Meyer teach or suggest all the limitations of claims 1, 13, and 22, either alone or in combination. For example, no cited reference discloses “a utility meter incorporating standard meter industry data structures including security data table parameters” having a “bypass component for enabling a data access operation by an external device without reference to the security data table parameters included within the utility meter” as recited in claim 1 and as recited with similar language in claims 13 and 22. (Emphasis added). As a consequence, Applicants respectfully submit that the obviousness rejection of claims 1, 13, and 22 should be withdrawn.

i. Germer

Germer teaches a method for operating an electronic electric meter having current and voltage sensors configured to generate measurements of current and voltage, respectively. (*See* Germer, Abstract). The meter of Germer also includes an optical port used for communicating data commands to and from an external reader to a microprocessor. (*See* Germer, col. 2, lines 26-31). Communications via the optical port are performed in accordance with ANSI C12.18 (optical port) and ANSI C12.19 (standard tables). *Id.* As admitted by the Examiner at page 5 of the December 23, 2008 Office action, Germer does not disclose a bypass component. Additionally, there is no disclosure that Germer utilizes security data tables under the ANSI

C12.19 standard. Furthermore, there is no suggestion by either Germer or the Examiner that Germer discloses an “internally generated access key”.

- ii. Germer does not Disclose “Enabling a Data Access Operation by an External Device Without Reference to the Security Data Table Parameters Included Within the Utility Meter”

As admitted by the Examiner at page 5 of the December 23, 2008 Office action, Germer does not disclose a bypass component. Moreover, Germer also fails to disclose “enabling a data access without reference to data table parameters” as alleged by the Examiner at page 5 of the Office action. What the Examiner alleges to be disclosed by Germer is merely a misquotation of the Applicants’ claim language. The Examiner alleges that Germer discloses “enabling a data access without reference to data table parameters”; however, the Applicants’ claim 1 recites “enabling a data access operation by an external device without reference to the **security** data table parameters”. (Emphasis added). Claims 13 and 22 include similar limitations. As admitted by the Examiner at page 6 of the December 23, 2008 Office action, Germer does not specifically disclose security tables. Therefore, Germer cannot disclose “a utility meter incorporating standard meter industry data structures including security data table parameters” having a bypass component for “enabling a data access operation by an external device without reference to the **security** data table parameters”, as claimed by the Applicants.

Furthermore, in an apparent attempt to demonstrate that Germer does indeed disclose the above quoted limitation, the Examiner cited two block passages of Germer. Specifically, the Examiner noted that col. 12, lines 38-50 allegedly discloses “data access” and col. 2, lines 25-41 allegedly discloses “ANSI C12.19 standard tables”. It is unclear to the Applicants in exactly what manner identifying “data access” and “ANSI C12.19 standard tables” demonstrates that Germer

discloses “enabling a data access a data access operation by an external device without reference to the security data table parameters”. (Emphasis added). Accordingly, the Examiner has not provided the Applicants with an “articulated reasoning with some rational underpinning to support the legal conclusion of obviousness” as required by MPEP § 2143.

The portion of Germer cited by the Examiner at page 5 of the December 23, 2008 Office action discloses a method of developing a “snap shot” of meter data and then reading the snap shot of meter data with an external device. To this end, upon a request for a communication session, the utility meter of Germer generates a static copy of the selected data and stores the data in RAM or EEPROM. The static snap shot is then read by an external device. The Examiner incorrectly concluded that because an external device may read meter data from a location other than the ANSI data tables that the data is being read “without reference to the security data table parameters”. As explained below, the Examiner’s conclusion is not supported by Germer.

There is no indication in Germer that an external device may access meter data without first referencing a security data table parameter, if Germer were combined with a reference having security data table parameters. In fact, the passage cited by the Examiner expressly discloses that an external device **must** communicate with the utility meter in accordance with ANSI data table parameters. Therefore, if Germer were combined with a reference having security data table parameters, an external device must access meter data with reference to the security data tables because, as cited by the Examiner, Germer does not disclose a bypass component. Specifically, Germer discloses that the optical port 122 is used to communicate data to and from an external reader to a microcomputer 114. (Germer, col. 2 lines 26-29). Germer then discloses that communications via port 122 are performed in accordance ANSI C12.18 (optical port) and ANSI C12.19 (standard tables). (*Id.* at lines 29-31). As disclosed by Kinter-Meyer and noted by the

Examiner at page 6 of the December 23, 2008 Office action, security data tables comprise a portion of the ANSI C12.19 standard tables. Therefore, even though Germer does not specifically disclose the use of security data tables under the ANSI C12.19 standard, the external device of Germer communicates via a port that operates under the ANSI C12.18 standard. Accordingly, if Germer were combined with a reference having security data tables, as suggested by the Examiner, any communication between an external device and the utility meter optical port must occur **with** reference to security data table parameters. Therefore, Germer does not disclose the limitation of “enabling a data access operation by an external device without reference to the security data table parameters included with the utility meter”.

B. There Is No Motivation To Combine Germer, Matyas, Haines, and Kinter-Meyer

i. Matyas

Matyas teaches a method of security data cryptography in which a data cryptography key is associated with a control vector to provide a method of authorization for the uses of the data cryptography key intended by the originator of the data cryptography key. (*See* Matyas, Abstract). The control vector is configured to be coupled to a system generated cryptography key; however, it is possible, though undesirable, to associate a control vector with a non system generated cryptography key, because the control vector is unable to detect the origin of a system generated cryptography key. (*See* Matyas, col. 15 lines 19-56.) Coupling a control vector to a non system generated cryptography key is referred to by Matyas and the Examiner as the “back-door” method. *Id.* As admitted by the Examiner at page 6 of the December 23, 2008 Office action, Matyas does not disclose a security component.

ii. Haines

Haines teaches a technique for reconfiguring in the field external devices in communication with postage meters, the external devices having a feature set that may be selectively enabled or disabled by software. (*See* Haines, Abstract). The meter is reconfigured by first putting the meter into an I/O configuration mode by suitable entries from the keyboard. A desired new IOCN is entered via keyboard entry. *Id.* The meter software generates an encrypted I/O configuration request code that is partially based on the value of the new IOCN. *Id.* The I/O configuration request code is communicated to a data center computer along with other validating identification information. *Id.* The data center computer checks the code by computing the I/O configuration request code using the same algorithm. *Id.* If the two values agree, the data center computer generates an encrypted I/O configuration enable code that is partially based on the meter serial number. *Id.* This is communicated to the meter, which receives the computer generated I/O configuration enable code and also generates an internal I/O configuration enable code using the same encryption algorithm as the data center computer. *Id.* If the I/O configuration enable codes agree, the meter overwrites the old IOCN with the new IOCN in permanent storage. *Id.* The external devices in communication with the meter may then read the IOCN and implement the feature set represented by the IOCN. *Id.*

iii. Kinter-Meyer

Kinter-Meyer is a report, which summarizes the findings of a research project conducted by the American Society for Heating, Refrigeration, and Air-Conditioning Engineers, Inc. (“ASHRAE”), entitled “*Utility/Energy Management and Controls System (EMCS) Communication Protocol Requirement*”. Among other things, Kinter-Meyer characterizes the

current state of the art in utility / end-user communication technology. (*See*, Kinter-Meyer, Executive Summary, page x).

iv. The Combination of Germer and Matyas is Improper

“There are three possible sources for a motivation to combine references: the nature of the problems to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art.” *In re Rouffet*, 149 F.3d 1350 (Fed. Cir. 1998). Furthermore, obviousness can be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so. MPEP § 2143.01. “Rejections on obviousness cannot be sustained with mere conclusory statements; instead there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” (MPEP § 2142).

In the December 23, 2008 Office action, the Examiner failed to establish a motivation for combining Germer and Matyas. Instead, on pages 5-6 of the Office action, the Examiner proposed different features shown in Germer and Matyas. On page 5 of the Office action, the Examiner admitted that Germer “does not disclose a bypass component”. However, the Examiner argued at page 6 that “back-door or bypass security methods are well known in the art as exemplified by Matyas”. The Examiner then stated that “it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Germer with the bypass of security features of Matyas since this allows for meter calibration and upgrade that would otherwise be denied access due to a data table read only restriction, incorporated by the ANSI C12.19 standard”.

Applicants respectfully submit that the foregoing motivation to combine Matyas with Germer is improper. What is lacking in Germer that would cause one to combine it with the

“back-door” system described in Matyas? Why would one of skill in the art at the time of the invention been motivated to combine the cited references to provide a utility meter that includes standard meter industry data structures including security data tables, while also configuring the same meter to allow data access operations “without reference to the security data table parameters”? Applicants respectfully submit that there was no motivation for such a combination at the time of the invention, and the Examiner’s suggestion of such a combination is no more than impermissible “hindsight”.

One indicator that the Examiner is using impermissible “hindsight” is that the prior art actually “teaches away” from the Examiner’s proposed combination. A prior art reference that “teaches away” from the claimed invention is a significant factor to be considered in determining obviousness; however, “the nature of the teaching is highly relevant and must be weighed in substance”. (MPEP § 2145). Furthermore, **proceeding contrary to accepted wisdom in the art is evidence of nonobviousness**. (MPEP § 2145; *citing In re Hedges*, 228 USPQ 685 (Fed. Cir 1983)).

The Examiner noted in the December 23, 2008 Office action, that according to Matyas, the back door method is “primarily an annoyance” and additional methods should be taken to avoid the back door method. Thus, Matyas discloses that it is desirable and simple to design an architecture that avoids the “back door” method. (*See* Matyas, column 15, lines 40-41). By contrast, the bypass component of the present application provides a desirable method of data access that includes such a “back door” method. With this in mind, it can be seen that **Applicant’s claimed invention proceeds contrary to the accepted wisdom cited by the Examiner in Matyas, and thus it is respectfully submitted that Matyas “teaches away” from the present invention under MPEP § 2145**. Because Matyas teaches away from the

claimed invention, the Examiner has not made a *prima facie* case of obviousness, and the Examiner's rejection of claims 1, 13, and 22 under 35 U.S.C. § 103 should be withdrawn.

v. The Combination of Germer, Matyas, and Haines is Improper

1. *The Examiner has Provided only a Conclusory Statement*

On page 7 of the December 23, 2008 Office action, the Examiner argued that "it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Germer/Matyas with the security component of Haines to authenticate data access operations". The Examiner, however, has provided no explanation of any shortcomings of Germer or Matyas or their alleged combination that would make the proposed combination with Haines desirable. Applicants respectfully request clarification on why one skilled in the art would have been motivated to provide the proposed combination in this manner. Absent a clear articulation of such motivations, it is respectfully submitted that the Examiner's stated motivation for combining Germer and Matyas with Haines is no more than a conclusory statement made with impermissible "hindsight".

2. *Haines is Non-Analogous Prior Art*

In addition to the foregoing, Applicants respectfully submit that the foregoing motivation for combining Germer and Matyas with Haines is improper because Haines is non-analogous prior art. In order to rely on a reference under 35 U.S.C. § 103, the reference must be analogous prior art. (MPEP § 2141.01(a)). A reference in a field different from that of Applicant's endeavor may be reasonably pertinent if it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his or her invention as a whole. *Id.* Accordingly, the determination that a reference is from a non-analogous art is twofold. First, an Applicant should demonstrate that the reference is in a field different from that

of the Applicant's endeavor. (*See id.*). Second, if it is not, it must be determined if the reference would have commended itself to an inventor's attention in considering his or her invention as a whole. (*See id.*).

First, Haines relates to the field of postage meters. The present invention, on the other hand, relates to utility meters, as set forth in each of the claims of the present application. Accordingly, the field of Haines is not within the field of the Applicants' endeavor.

Second, Haines would not have commended itself to the Applicants' attention in considering his or her problem as a whole. Applicant's problem, as set forth in the background section of the application, involves bypassing the security provided by security tables in a utility meter so that a technician may write data into the meter's data tables, such as when a meter is out of calibration and requires service. Conversely, Haines involves a technique for reconfiguring a postage field device with a new I/O configuration number, which will allow new features to be used in the postage device. It is respectfully submitted that these problems are unrelated, as one problem involves allowing security tables to be bypassed in order to allow data to be written to other tables within the utility meter, and the other problem involves entry of a code that opens new functionality in a postage device. Accordingly, because Haines is non-analogous prior art, it is respectfully submitted that the Examiner has failed to make a *prima facie* case of obviousness, and the rejection of claims 1, 13, and 22 under 35 U.S.C § 103(a) should be withdrawn.

Applicants submitted a similar argument with respect to the combination of Hoffman with Matyas and Haines in response to the May 29, 2008 Office action. The Examiner, however, did not respond to the argument because the argument is allegedly "moot in light of the new grounds of rejection". (December 23, 2008 Office action, page 2). Applicants respectfully request the Examiner to consider this argument.

C. Conclusion as to the Rejection of Claims 1, 13, and 22 Under 35 U.S.C. § 103(a)

No cited reference discloses each limitation of claims 1, 13, and 22. For example, Germer does not disclose “enabling a data access operation by an external device without reference to the security data table parameters” as recited in claim 1 and as recited with similar language in claims 13 and 22. Additionally, there is no motivation to combine Germer, Matyas, Haines, and Kinter-Meyer. Therefore, the rejection of claims 1, 13, and 22 under 35 U.S.C. § 103(a) should be withdrawn.

VI. The Rejection of Claims 2-12 and 14-21 Under 35 U.S.C § 103(a) Should Be Withdrawn

In the December 23, 2008 Office action, the Examiner rejected dependent claims 2-12 and 14-21 under 35 U.S.C. § 103(a). Each of the above claims depends from and incorporates all of the limitations of one of independent claims 1 or 13. As set forth above, the Examiner’s rejection of claims 1 and 13 should be withdrawn. Therefore, because each of dependent claims 2-12 and 14-21 depends from and incorporates all of the limitations of one of independent claims 1 or 13, the Examiner’s rejection of dependent claims 2-12 and 14-21 should also be withdrawn for at least the same reasons.

VII. Request to Correct Inventor’s Name in Patent Application

In the response to the Office action of May 29, 2008 Applicants requested the USPTO to issue a new filing receipt including the correct spelling of the first-named Applicant’s last name. In particular, the USPTO spelled the first named Applicant’s name “Girsham” instead of “Grisham”. The declaration submitted on April 30, 2004 clearly shows that the Applicant’s name should be spelled “Grisham”. This error in the spelling of the first-named Applicant’s last name

appears to be due to USPTO error. Accordingly, it is respectfully submitted that the USPTO records should be revised and a new filing receipt should be sent to the Applicants. It is believed that no fee is necessary for this correction since the error appears to be on the part of the USPTO.

VIII. Conclusion

For all of the foregoing reasons, it is respectfully submitted the Applicants have made a patentable contribution to the art. Favorable reconsideration and allowance of this application is therefore respectfully requested.

Applicants hereby petition for a one month extension of time to respond to the December 23, 2008 Office action. Applicants authorize \$130.00 to be deducted from deposit account 13-0014. In the event the Applicants have inadvertently overlooked the need for an additional extension of time or payment of an additional fee, the Applicants conditionally petition therefore, and authorize any fee deficiency to be charged to deposit account 13-0014.

Respectfully submitted,

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